REMARKS

A. Introduction

Claims 1-10 are pending and under consideration in the application.

In the Office Action of December 4, 2008 ("the Office Action"), the drawings were objected and claims 1-10 were rejected as obvious.

In response, the specification has been amended and the rejection of the claims is traversed. No new matter is added.

B. Objection to the Drawings

The Examiner objected to the description of the drawings within the Specification. The Specification has been amended as suggested by the Examiner.

The Examiner further objected to the Drawings due to an "S," which is depicted on line head 20 as part of a group of figures, i.e., "CMYKS." *See* Figure 2. The figures "CMYKS" are well known to refer to colors: cyan, magenta, yellow, black, and special. The Specification has been amended accordingly.

In view of the amendments to the Specification, withdrawal of the objections is requested.

C. Rejection under 35 USC §103

Claims 1, 2, 4, and 5 have been rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent Publication No. 2004/0001134 to Nakazawa in view of U.S. Patent Publication No. 2002/0097290 to Koitabashi. Applicant traverses these rejections for at least the following reasons.

Independent claims 1 and 4 recite, *inter alia*, "an ink absorption amount in 100 msec of 15 mL/m^2 or more." The Examiner acknowledges that Nakazawa is deficient and does not disclose or suggest these limitations. In an attempt to remedy the Nakazawa deficiency, the Examiner argues that Koitabashi teaches an aqueous ink

having the claimed absorption rate. However, Koitabashi is limited to an absorption amount in 100mS of 100mL/m^2 or more, which is not the same as 100 msec of 15 mL/m^2 or more for at least the reason that Koitabashi specifically excludes the range of 15 mL/m^2 to 99mL/m^2. *See* the passage relied on by the examiner, Koitabashi, para. 61. Thus, the references do not teach or suggest all of the limitations recited in independent claims 1 and 4.

Further, Koitabashi specifically teaches away from any lower absorption amounts via the statement: "[i]f it is in this range [of 100mS of 100mL/m^2 or more], even in the case of making multi-printings, occurrences of bleeding, repelling, and beadings can be prevented." *See* Koitabashi, para. 61. Thus, it is unreasonable to suggest that one would be motivated to employ an absorption amount because such would not prevent "bleeding, repelling, and beadings."

Still further, Nakazawa teaches away from Koitabashi. Nakazawa is limited to an oil-based ink and specifically rejects aqueous inks to avoid problems associated with aqueous inks, i.e., to avoid "cockling of paper due to ink absorption, as with aqueous ink, does not occur, and there are fewer constraints on the recording medium." *See* Nakazawa, para. 55. Thus, Nakazawa specifically teaches away from Koitabashi by requiring a completely contradictory approach to the ink employed by either printing device, and therefore one of ordinary skill in the art would not have been motivated to combine these references, and no expectation of success in combining these references exist. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (References are not properly combinable or modifiable if their intended function is destroyed).

The Examiner argues that "Koitabashi expresses a preference for a higher ink absorption rate," and this "provides motivation…to focus on the bottom of the Koitabashi suitable range…and to explore acceptable levels below that range." *See* the Office Action, pg. 16. The Examiner's conclusion is completely unfounded. There is absolutely no teaching within Koitabashi to either focus on the bottom of the disclosed range or explore below the disclosed

range. Clearly, the Examiner is using impermissible hindsight.

> When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
> (A) The claimed invention must be considered as a whole;
> (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
> (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
> (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Accordingly, because (1) the references do not teach or suggest all of the limitations recited in independent claims 1 and 4; (2) the references relied upon are not combinable without destroying the intended purpose of the references, and (3) there is no motivation to combine the references relied upon to result in the Applicant's invention as claimed, independent claims 1 and 4 are patentable over the references and withdrawal of these rejections and allowance of these claims are earnestly solicited. Likewise, claims 2, 3, and 5-10 depend from either independent claims 1 or 4 and include all of the limitations of independent claims 1 and 4. Accordingly, dependent claims 2, 3, and 5-10 are also allowable over these references for at least the same reasons discussed above with respect to claims 1 and 4.

D. Conclusion

In view of the foregoing, it is submitted that claims 1-10 are allowable and that the application is in condition for allowance. Notice to that effect is requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to out Deposit Account No. 19-3140.

Respectfully submitted,

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